



05/27/05

PATENT
450100-03223

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AF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Yoshimasa UTSUMI
Serial No. : 09/858,172
For : INFORMATION PROVIDING APPARATUS, SERVER
APPARATUS AND INFORMATION PROCESSING METHOD
Filed : May 15, 2001
Examiner : Traci L. Smith
Art Unit : 3629

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Date of Deposit: **May 26, 2005**

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RESPONSE PURSUANT TO 37 CFR 1.116

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Final Office Action mailed in the above-identified application on April 6, 2005. In light of the remarks to follow, reconsideration and allowance of this application are respectfully solicited.

In the Final Office Action under reply, the Examiner repeats her rejection as a “same invention” type double patenting rejection and contends that claims 1-12 of the present application “are directed to the same invention as that of claims 1-17 of commonly assigned U.S. Patent No. 6,658,401.” In the response filed January 18, 2005 in reply to the Office Action of October 19, 2004, Applicant’s representative pointed out the differences between the claims of the present application and the claims of the ‘401 patent in an effort to refute the Examiner’s previous double patenting rejection. The Examiner now explains why she disagrees with Applicant’s arguments:

“Applicant argues that the instant application is ‘might be used to determine who is infringing upon his patent’ and Patent ‘402 ‘might be used to invalidate a patent’, the second receiving means is capable of receiving both, there for does not qualify as patentably distinct. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. ... Arguments made in papers filed were directed solely to the 35 USC 102(e) rejection and the applicant does not argue the 35 USC 101 rejection the rejection stands.”

Applicant first will address the points raised in the Examiner’s “Response to [Applicant’s] Arguments.”

Applicant does not argue the 35 USC 101 rejection the rejection stands

The Examiner’s attention is directed to Applicant’s arguments commencing with the second full paragraph at page 2 and ending at the bottom of the second full paragraph at page 3 of the Response filed January 18, 2005. These arguments point out that the inventions defined by “the claims of the present application and the claims of the ‘402 patent ... are not identical” because the subject matter recited in the application claims differs from the subject matter recited

in the patent claims. Applicant argued that the claims of the present application are not directed to the same invention as that of the claims of the '402 patent and that one who practices the claims of the present application would not infringe the claims of the '402 patent and vice versa. "[T]his is the basis for a finding of no double patenting (see MPEP section 804 II A)."

It is incorrect to state that "the applicant does not argue the 35 USC 101 rejection." The rejection does not "stand" simply because Applicant did not refer to the statute in his argument -- clearly, Applicant presented cogent, convincing arguments why the double patenting rejection under 35 USC 101 is in error and should be withdrawn. It is just as clear, the Examiner disagrees with those arguments and has repeated her double patenting rejection. Should the Examiner persist in her double patenting rejection, it is likely that rejection will be reviewed.

*In a claim drawn to a process of making,
the intended use must result in a manipulative
difference as compared to the prior art.*

Insofar as claims 1-11 of the present application are concerned, this statement is inapposite. Claims 1-11 are directed to apparatus and not to a method. Claim 12, however, is a method claim. Claim 12 recites, "an information processing method." Claim 12 is not directed to "a process of making" as stated at page 3 of the Final Office Action. Accordingly, the Examiner's statement regarding intended use of a process of making is not relevant to the issue of double patenting of claims 1-12.

*The second receiving means is capable
of receiving both, there for does not qualify
as patentably distinct.*

The Examiner is focusing on Applicant's argument, presented as an example of how one would use Applicant's claimed invention, and not on the claims themselves. Turning first to the

requirements of 35 USC 112, “The specification shall contain a written description of the invention, and of the manner and process of making and using it ... as to enable any person skilled in the art ... to make and use the same...”. The function of the claims is to particularly point out and distinctly claim the invention. Applicant’s argument of how one would use Applicant’s claimed invention thus is consistent with the statutory requirement of describing how one would make and use the invention. This is not the same as a claim recitation of intended use of the claimed apparatus.

The Examiner’s argument, “if the prior art structure is capable of performing the intended use, then it meets the claim,” appears to be directed to a prior art rejection based upon 35 USC 102 or 35 USC 103 -- it is not particularly relevant to a double patenting rejection based upon 35 USC 101, as will be discussed below. Here, however, the Examiner is referring to the capability of the “second receiving means” recited by, for example, claim 1 of the present application and claim 1 of the ‘401 patent. The distinguishing element in the “receiving means” recited in both claims is as follows: claim 1 of the present application points out that the received information “concern[s] possible infringement on said right;” whereas claim 1 of the ‘401 patent points out that the received information “[is] for use in invalidating said right.” While the second receiving means of claim 1 of the ‘401 patent may be “capable of receiving both [the information concerning possible infringement on said right and information for use in invalidating said right],” the fact that the claimed invention of the present application is for a purpose that is completely different from the purpose of the claimed invention of the ‘401 patent makes this theoretical “capability” irrelevant. There is no point in having the second receiving means of claim 1 of the present application receive information for use in invalidating the right held by a right holder because there is nothing in claim 1 that would make use of this information.

Likewise, there is no point in having the second receiving means of claim 1 of the '401 patent receive information concerning possible infringement on the right held by a registered party because there is nothing in claim 1 of the '401 patent that would make use of this information. In the context of the claims, notwithstanding their theoretical capabilities, the second receiving means of the present application receives different information than the second receiving means of the '401 patent -- and this cannot be ignored. When considering the issue of "same invention" double patenting under 35 USC 101, all of the words of the claims must be compared. The capabilities of the claimed elements do not determine whether the claim of an application is directed to the "same invention" as the claim of the patent, especially if the words of the claims are different, as they are here.

Contrary to the Examiner's inference that "intended use" of the claimed apparatus should be ignored, Applicant points out that the actual uses of the respective inventions differ. The words of claim 1 of the present application describe the use of the claimed apparatus: charge processing (e.g. to determine consideration to be paid) for information transmitted by a reader concerning possible infringement on the right (e.g. patent right) held by a registered party. Likewise, the words of claim 1 of the '401 patent describe the use of the claimed apparatus: charge processing to determine consideration to be paid for information transmitted by a reader to invalidate the right (e.g. patent right) held by a right holder. These are not merely intended uses of the claimed apparatuses. These are actual uses that are quite different, indeed, they are opposite, from each other.

The claims of the application must be compared to the claims of the patent to determine whether the claims are directed to the same invention

As specified by the MPEP Sec. 804 II A, Requirements of a Double Patenting Rejection,
Statutory Double Patenting – 35 U.S.C. 101,

“A reliable test for double patenting under 35 USC 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent [citation omitted]. Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist.”

Clearly, and as was argued in Applicant’s response filed January 18, 2005 there is an embodiment of the invention defined by claim 1 of the present application that does not fall within the scope of a claim of the ‘401 patent.

Claim 1 of the present application recites the following elements: “first receiving means,” “storing means,” “transmitting means,” “second receiving means” and “charge processing means.” Only claims 1 and 7 of the ‘401 patent recite these elements. Accordingly, to determine whether the “same invention” is being claimed in the present application as is being claimed in the ‘401 patent, it is appropriate to compare claim 1 of the present application to claims 1 and 7 of the ‘401 patent. The following tables provide that comparison:

| Claim 1 of the present application | Claim 1 of the ‘401 patent |
|---|---|
| An information providing apparatus comprising: | An information providing apparatus comprising: |
| first receiving means for receiving information about a <i>right held by a registered party</i> , and information for charge processing with regard to said registered party; | first receiving means for receiving information entered by a registered party about a <i>right held by a right holder</i> , and information for charge processing with regard to said registered party; |
| storing means for storing the information which is entered by said registered party about said right and which is received by said first receiving means; | storing means for storing the information which is entered by said registered party about said right held by said right holder and which is received by said first receiving means; |
| transmitting means for readably transmitting to the general public the information stored in said storing means with regard to said right | transmitting means for readably transmitting to the general public the information stored in said storing means with regard to said right |

| Claim 1 of the present application | Claim 1 of the '401 patent |
|--|--|
| held by said <i>registered party</i> ; | held by said <i>right holder</i> ; |
| second receiving means for receiving information transmitted by a reader <i>concerning possible infringement on said right</i> ; and | second receiving means for receiving information which is transmitted by a reader <i>for use in invalidating said right</i> ; and |
| charge processing means for effecting charge processing regarding said registered party based on the information for charge processing received by said first receiving means with respect to said registered party. | charge processing means for effecting charge processing causing said registered party to pay a consideration to said reader for the <i>information provided to invalidate said right</i> , said charge processing being performed based on the information for charge processing with regard to said registered party. |

| Claim 1 of the present application | Claim 7 of the '401 patent |
|--|---|
| An information providing apparatus comprising: | An information providing apparatus comprising: |
| first receiving means for receiving information about <i>a right held by a registered party</i> , and information for charge processing with regard to said registered party; | first receiving means for receiving information entered by a registered party about <i>a right held by a right holder</i> , and information for charge processing with regard to said registered party; |
| storing means for storing the information which is entered by said registered party about said right and which is received by said first receiving means; | storing means for storing the information which is entered by said registered party about said right held by said right holder and which is received by said first receiving means; |
| transmitting means for readably transmitting to the general public the information stored in said storing means with regard to said right held by <i>said registered party</i> ; | transmitting means for readably transmitting to the general public the information stored in said storing means with regard to said right held by <i>said right holder</i> ; |
| second receiving means for receiving information transmitted by a reader <i>concerning possible infringement on said right</i> ; and | second receiving means for receiving information which is transmitted by a reader as <i>a token of willingness to invalidate said right</i> ; and |
| charge processing means for effecting charge processing regarding said registered party based on the information for charge processing received by said first receiving means with | charge processing means which, <i>if said reader invalidates said right, then effects charge processing causing said registered party to compensate said reader for the invalidation of</i> |

| | |
|-----------------------------------|--------------------|
| respect to said registered party. | <i>said right.</i> |
|-----------------------------------|--------------------|

Those elements that are italicized represent the elements of one claim that find no correspondence in the claim to which it is being compared. These italicized elements represent the embodiment of the invention that falls within the scope of one claim but not the other. Thus, as mandated by the MPEP, “identical subject matter is not defined by both claims and statutory double patenting would not exist.”

It is clear from the foregoing tables of comparison, the “first receiving means” of claim 1 of the present application receives information “about a right held by a registered party” whereas the “first receiving means” of claim 1 of the ‘401 patent receives information “about a right held by a right holder.” There is disclosed an embodiment wherein the registered party is not the right holder. Hence, the two claims do not define “identical subject matter.”

The “transmitting means” of claim 1 of the present application transmits information with regard “to said right held by said registered party;” whereas claim 1 of the ‘401 patent transmits information with regard “to said right held by said right holder.” Since there is an embodiment wherein the registered party is not the right holder, it follows that the two claims do not define “identical subject matter.”

The “second receiving means” of claim 1 of the present application receives information “concerning possible infringement on said right;” whereas the “second receiving means” of claim 1 of the ‘401 patent receives information “for use in invalidating said right.” An embodiment is described wherein infringement on said right is not invalidating said right. Hence, the two claims do not define “identical subject matter.”

Finally, the “charge processing means” of claim 1 of the ‘401 patent causes the registered party to pay a consideration to the reader “for the information provided to invalidate said right.” Claim 1 of the present application does not recite a similar limitation. Hence, there is an embodiment of the invention claimed in the present application that does not fall within the scope of claim 1 of the ‘401 patent. Therefore, “identical subject matter” is not defined by both claims; and consistent with the MPEP, statutory double patenting does not exist.

A similar comparison of claim 1 of the present application to claim 7 of the ‘401 patent yields the same result. It is noted, the “second receiving means” of claim 1 of the present application receives information “concerning possible infringement on said right;” whereas the “second receiving means of claim 7 of the ‘401 patent receives information that is “a token of willingness to invalidate said right.” These limitations of the claims are completely different; and an embodiment that falls within the scope of one does not fall within the scope of the other.

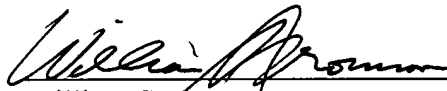
The “charge processing means” of claim 7 of the ‘401 patent causes the registered party to compensate the reader for invalidation of the right if the reader invalidates the right. There is nothing comparable to this limitation in claim 1 of the present application. Consequently, an embodiment that falls within the scope of claim 1 of the present application would not literally infringe claim 7 of the ‘401 patent.

When the *claims* of the present application are compared to the *claims* of the ‘401 patent, there can be no finding of identical subject matter being claimed by both. This is the fundamental requirement to support a statutory double patenting rejection. As stated in the MPEP, there is an embodiment of the invention that falls within the scope of the claims of the present application but not the claims of the ‘401 patent. Claim 1 of the present application

could be literally infringed without literally infringing claim 1 or claim 7 of the '401 patent. The comparison tables and discussion above clearly and unmistakably point this out.

Therefore, since the only rejection set out in the Final Rejection under reply is a statutory double patenting rejection (it is noted the Examiner correctly has not set out or implied that the invention claimed in this application is an obvious variation of the invention claimed in the '401 patent), and since the MPEP holds this rejection to be improper, the withdrawal of the double patenting rejection is respectfully solicited.

Respectfully submitted,
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PATENT
450100-03223

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P.O. Box 1450
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Dear Sir:

Transmitted herewith is an amendment in the above-identified application.

- ☒ No additional fee is required.
☐ The fee has been calculated as shown below.
☐ This is an application of a small entity under 37 CFR 1.9(f), and the amounts shown in parentheses apply.

Claims as Amended

| (1) | (2) Claims remaining after amendment | (3) | (4) Highest number previously paid for | (5) Present extra | (6) Rate | (7) Additional Fee |
|---|--|-------|--|----------------------|-------------|--------------------------|
| Total claims | 12 | Minus | ** =20 | * 0 x | \$50 (25) | = \$ 0 |
| Independent claims | 3 | Minus | *** =3 | * 0 x | \$200 (100) | = \$ 0 |
| Total additional fee for this amendment | | | | | | \$ 0 |

- * If the entry in Column 2 is less than the entry in Column 4, write "0" in Column 5.
** If the highest number of total claims previously paid for is less than 20, write "20" in this space.
*** If the highest number of independent claims previously paid for is less than 3, write "3" in this space.

- ☐ This application contains a multiple dependent claim. The required fee of \$360(180) has been previously paid ☐, or is paid herewith ☐.
- ☐ This response is being filed within the ____ month following the expiration of the term originally set therefor. This is a petition to request a ____ month extension of time. A check covering the cost of the petition is enclosed.
- ☐ A check in the amount of \$ ____ is attached, which covers the cost of ☐ additional claims ____ petition for extension of time.
- ☐ Charge \$ ____ to Deposit Account No. 50-0320.
- ☒ Please charge any additional fees incurred by reason of this response or credit any overpayment to Deposit Account No. 50-0320.

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Respectfully submitted,

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